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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,567	05/26/2005	Ulrich Sander	33997.0115	2192
26712	7590	10/25/2007		
HODGSON RUSS LLP THE GUARANTY BUILDING 140 PEARL STREET SUITE 100 BUFFALO, NY 14202-4040			EXAMINER CONSILVIO, MARK J	
			ART UNIT 2872	PAPER NUMBER
			MAIL DATE 10/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/536,567

Applicant(s)

SANDER, ULRICH

Examiner

Mark Consilvio

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/11/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 14-29 were previously rejected and claims 15-17 and 28 are newly amended.

Claims 14-29 are currently pending.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 08/11/2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (US Patent Application Publication No. 2001/0010592) in view of Biber (US Patent No. 5,898,518).

With respect to claim 14, Nakamura discloses an apparatus comprising: a main microscope (1) including a main objective (21) having an optical axis (K1), a pair of main stereoscopic observation beam paths passing through the main objective (21), and a zoom (22) in

Art Unit: 2872

the main observation beam paths, the zoom having an axis arranged at an angle to the optical axis (K1) of the main objective (21); an assistant's microscope (26); and a beam splitter (B1) arranged in the main observation beam paths before the main objective (21) and the zoom (22) for reflecting out a pair of assistant's stereoscopic observation beam paths to the assistant's microscope; wherein the beam splitter (B1) is continuously rotatable, together with the assistant's microscope (26), relative to main microscope (1) about the optical axis (K1) of the main objective (21), whereby the beam splitter (B1) and assistant's microscope (26) are optically usable in any rotational position (figs. 1-5). Nakamura does not expressly disclose the beam splitter arranged between the main objective and the zoom. However, Biber discloses a similar stereomicroscope with an assistant's microscope (37) attached wherein the assistant's microscope (37) is disposed between the main microscope (38) (including a zoom system) and the main objective (30) (fig. 3a) and teaches that the desirability of this arrangement so that an assistant can adjust the illumination system for the main observer and vice versa (col. 1, lines 51-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to arrange the beam splitter of Nakamura between the main objective and zoom system for the advantages taught by Biber (col. 1, lines 51-65) and/or to reduce the number of parts (i.e. multiple objectives) as would have been understood by one of ordinary skill.

With respect to claim 15, Nakamura discloses the zoom (22) includes an optical system in each of the pair of main stereoscopic observation beam paths (fig. 3).

With respect to claim 16, Nakamura discloses the axis of the zoom (22) extends substantially perpendicular to the optical axis (K1) of the main objective (21) (par. 44).

With respect to claim 17, Nakamura discloses the assistant's microscope (26) is mechanically detachable from the main microscope (1) (par. 15).

With respect to claim 18, Nakamura discloses the beam splitter (B1) is mechanically detachable from the main microscope (1) together with the assistant's microscope (26) (fig. 2).

With respect to claim 19, Nakamura discloses the assistant's microscope (26) includes a deflection element (27) for receiving the pair of assistant's stereoscopic observation beam paths along an assistant's microscope axis (K4) and redirecting the pair of assistant's stereoscopic observation beam paths into an assistant's binocular tube (19) (fig. 2).

With respect to claim 20, Nakamura discloses the assistant's microscope (26) further includes optical components in the assistant's microscope axis (K4) between the beam splitter (B1) and the deflection element (27), the optical components (IR) providing an image rotation between the beam splitter and the deflection element (figs. 5-7).

With respect to claim 21, Nakamura discloses the deflection element (27) is rotatable relative to the beam splitter (B1) about the assistant's microscope axis (K4) (par. 41).

With respect to claim 22, Nakamura suggests the rotation of the beam splitter (B1) together with the assistant's microscope (26) is drivable in motorized or manual fashion.

With respect to claim 23, Nakamura discloses deflection element (27) is rotatable relative to the beam splitter (B1) to vary a tilt angle between the assistant's microscope axis (K4) and the direction of the pair of assistant's stereoscopic observation beam paths after redirection by the deflection element (27) (fig. 5).

With respect to claim 24, Nakamura suggest the main objective (21) has a fixed focal length (i.e. when the lenses L2 are not moved).

With respect to claim 25, Nakamura suggests the main objective (21) has a variable focal length (par. 32).

With respect to claim 26, Nakamura does not expressly an illumination beam path directed through the main objective. However, it is well known in the art that illumination beams may be directed through the main objective of a microscope. For example, Biber teaches such an arrangement (figs. 1a-3b). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide an illumination beam path directed through the main objective as an alternative to the arrangement of Nakamura so that the objective lenses may be used to focus the illumination beam on the subject thereby eliminating the need for additional focusing lenses.

With respect to claim 27, Nakamura discloses the main objective (21) is divided into at least two parts (par. 32).

With respect to claim 28, the combination of Nakamura and Biber suggests a first part (L2) of the main objective is used for the main observation beam paths of the main microscope, and a second part (M1) of the main objective is used for the illumination beam path, the second part being spaced from the first part and arranged at an angle to the optical axis (Nakamura figs. 2-3).

With respect to claim 29, Nakamura does not expressly disclose the main objective is rotatable, together with the illumination beam path, about the optical axis of the main objective. However, Biber teaches such an arrangement may be desirable (col. 4, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allow the main objective to be rotatable, together with the illumination beam path, about the optical

Art Unit: 2872

axis of the main objective so that the illumination system can be incorporated into the main body housing the objective.

Response to Arguments

Applicant's arguments filed 08/11/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the Biber reference does not provide a motivation for the proposed combination, the examiner disagrees. Nakamura fails to teach that the illumination is optimized for both observation paths. However, Biber teaches an arrangement wherein such optimization may take place for both observation paths. This arrangement includes a shared objective and beam path. And, therefore, the Biber reference suggests moving the beam splitter between the objective and zoom system as shown by Biber.

In response to applicant's argument that the Nakamura reference teaches away from the proposed combination, the examiner recognizes that a prior art reference must be considered in its entirety, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also MPEP § 2123. It is important to recognize that the prior art must not be read in a vacuum, but in light of the knowledge of one of ordinary skill. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983)

Art Unit: 2872

(quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

Further, Nakamura only teaches the desirability of independent magnification adjustment. Not only would one of ordinary skill recognize that this feature is an optional alternative to other prior art teachings, this feature is not necessarily negated by the use of a single objective (or more specifically the proposed combination). Note, for example, fig. 5A of Tanaka (US 4,640,588) showing independent zoom systems after a main objective and beam splitter.

In response to applicant's argument that the proposed combination is a more challenging design feature, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Again, not only would one of ordinary skill recognize that this feature (i.e. attachment of the assistant microscope at the bottom of the main microscope body) is an optional alternative to other prior art teachings, attachment of the assistant microscope at other locations was well known in the art at the time of the invention. See, for example, Howes (US 5,528,426) or Kleinberg (US 5,052,789) or Corbisiero et al. (US 6,421,173) or Minami et al. (US 4,763,968) which all teach modular/detachable assistant microscopes.

Art Unit: 2872

In response to applicant's argument that the proposed combination does not meet the limitations of amended claim 28 drawn to two objective parts, it is noted that the only support for the new limitations can be found in fig. 1 of the applicant's specification where the "first part" refers to element 2 and the "second part" refers to element 13. Applicant does not appear to have support according to 35 USC 112, 1st paragraph for any alternative interpretations. Further, it is noted that the proposed combination does not require or preclude a two-part objective as applicant suggests. It only indicates that a possible advantage to the combination is that separate objectives would not be required (though a single objective may still be composed of multiple lenses or parts).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2872

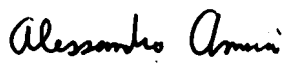
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Thursday, 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MC
10/15/2007


ALESSANDRO AMARI
PRIMARY PATENT EXAMINER